

REMARKS

The Office Action of August 10, 2005 has been reviewed and the Examiner's comments carefully considered. Applicant hereby elects Group I, as set forth in claim 2, together with claims 1 and 4, for further examination. Furthermore, Applicant also selects Species B, where the probe is vibrated parallel to blade vibration. Applicant further reserves the right to file, at a later time, divisional applications directed to the non-elected inventions. The present Election withdraws claims 3 and 5-14, contingent upon the following grounds of traversal. Pursuant to 37 C.F.R. § 1.48(b), there is no change in inventorship as a result of this election.

The Examiner has indicated that the present invention includes six distinct inventions, namely: Group I, as set forth in claim 2, directed to a process of using an ultramicrotome to cut a probe into thicknesses of about 10 nm to 100 nm; Group II, as set forth in claims 3 and 12, drawn to a process of using an ultramicrotome where the blade has a vibration amplitude of $1 \mu\text{m}$, or $a \geq 10v/w$; Group III, as set forth in claims 5-10, drawn to a process of using ultramicrotome where the probe vibrates parallel or perpendicular to the blade vibration; Group IV, as set forth in claim 11, drawn to a process of using ultramicrotome where the probe has a vibration amplitude of $b \geq v/2w$; Group V, as set forth in claim 13, drawn to a process of using ultramicrotome where the blade is a diamond; and Group VI, as set forth in claim 14, drawn to a process of using an ultramicrotome where the blade is advanced at a constant speed. In addition, the Examiner has indicated that claims 1 and 4 will be examined with the election of any of these groups, and claim 1 links the inventions of Groups I-VI. The Examiner believes that the application contains claims directed to two distinct species of the invention, namely: Species A, where the probe is

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vibrated perpendicular to the blade vibration; and Species B, where the probe is vibrated parallel to the blade vibration.

The Examiner is thanked for indicating that the present application contains no less than six distinct inventions. However, Applicant respectfully traverses the restriction requirement with respect to Groups I-VI. In particular, Applicant believes that the process of using the ultramicrotome in claims 1-14, where the blade is vibrated in certain manners, made from specified materials and achieve certain desired thicknesses, as described in claims 3 and 5-14, are so closely related, that a complete search of one invention must necessarily include a search of the other. Consequently, it is submitted that there can be no significant burden on the Examiner for maintaining these six distinct inventions in a single application.

The Examiner indicates, in Paragraph 4 of the Office Action, that there is an excessive burden on the Office to examine all of these inventions together. Specifically, the Examiner indicates that the search for Group I would be a text search for probes and thicknesses, and the search for Group II would be text searches for amplitudes and blades. Further, the Examiner cites to MPEP § 808.02(C). Applicant submits that this section of the Manual relates to different fields of search. The process for cutting sections from a probe for microscopic analysis by using an ultramicrotome device as disclosed in the various claims of the present application would not require a different field of search simply for different ways of operating the ultramicrotome. This process can be individually classified, and it would not be necessary for the Examiner to search for one of the distinct subjects in places where no pertinent art to the other subject exists, which is a requirement of Section 808.02(C) of the

Manual. This Section is not directed to the possibility that the Examiner needs to use different search terms when forming a query in the Patent Office's computer system.

In addition, in order to restrict the claims, the various inventions in the claims must be both "independent" and "distinct". "The term 'independent' (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process." MPEP § 802.01. In addition, the term "distinct" means that the multiple subjects are patentable over each other.

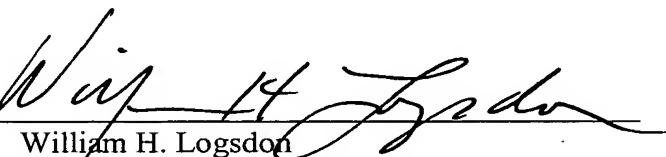
It is respectfully submitted that the multitude of Groups identified by the Examiner are not "independent" and "distinct", as defined in the statute and Manual. For example, the process described in independent claim 1 specifically discusses the various directions and movement of the blade of the ultramicrotome device for cutting sections. Claim 2 of the present application discusses the thicknesses of the resulting sections, and, for example, claim 3 discusses the maximum amplitude of vibration of the blade. Both of these limitations could be used in connection with independent claim 1 to effectively achieve the same result (or effect), and therefore have a specifically-disclosed relationship (and, hence, are not "independent"). In addition, when engaging in the process described in independent claim 1, since the results and sub-steps described in the dependent claims could lead to identical results, these claims cannot be considered "distinct", as required in the statute and the Manual.

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Applicant believes that claims 1, 2 and 4 are patentable over the cited prior art and in condition for allowance. In addition, to the extent the restriction requirement is withdrawn, claims 3 and 5-14 are also patentable over the cited prior art and in condition for allowance. Accordingly, allowance of all claims is respectfully requested.

Respectfully resubmitted,
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